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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,335	08/15/2003	Edwin C. Bailey	14518.(new)	1938
26712	7590	11/02/2005	EXAMINER	
HODGSON RUSS LLP ONE M & T PLAZA SUITE 2000 BUFFALO, NY 14203-2391			RODRIGUEZ, JOSEPH C	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/642,335

Applicant(s)

BAILEY, EDWIN C.

Examiner

Joseph C. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

***Final Rejection***

Applicant's arguments filed 8/1/05 have been fully considered but they are not persuasive for reasons detailed below.

The prior art rejections are maintained or modified as follows:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as anticipated by Adams et al. ("Adams I")(US 6,152,307) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van den Sype et al. ("Sype")(US 4,042,423) and Adams et al. ("Adams II")(US 6,186,337).

Regarding claims 1, 2, Adams I teaches a method of sorting comprising providing a screen having a first and second planar array of wires (Fig. 34A-34E; col. 20, ln. 63- col. 21, ln. 27 teaching wire mesh of mesh 1, 2, 3—i.e., wire diameter of between 1/16 and 5/8<sup>th</sup> inches or Fig. 45E, F col. 25, ln. 30-66 teaching mesh range of between 2 and 32) and passing granular product through said screen for sorting (col. 1, ln. 35-40). Here, Adams I appears silent on the type of wire used and the tensile strength of said

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wire in the specific embodiments cited above, but gives examples in other embodiments that uses a type of wire, 304 stainless steel, that can be produced with the desired tensile strength (col. 25, ln. 40-68). Thus, the feature of stainless steel with a specific tensile strength can be regarded as inherent. Further, Adams I teaches a shaker screen assembly that is commonly used to process aggregates that are other than food grade or corrosive to steel (Abstract).

Regarding claims 3-5, the claimed steps *still* relate to a method of making the screen rather than the method of sorting. Here, Examiner previously advised applicant that mixing statutory classes of invention may lead to indefiniteness during claim interpretation, thus Examiner sought Applicant to clarify the record on the type of claim Applicant had wished to create. See MPEP 2173.05(p). Further, although Applicant states that these claims are directed to a method of sorting the language itself is still directed to a method of making, thus the method steps in claims 3-5 resemble product-by-process limitations and have been treated as such. That is, the limitations relating to how the screen is formed would not be expected to impart distinctive characteristics to the method of sorting and, moreover, when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct (see Adams I, col. 2, ln. 9-14 teaching that bonding includes a welding connection; col. 20, ln. 65-67 teaching that screen layers may be welded). Thus, claims 3-5 can be regarded as anticipated by the applied prior art and the burden of proof is shifted to Applicant, not the Examiner, to show that the process of

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making renders the claims patentably distinct. See *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

Adams I as set forth above teaches all that is claimed. However, under an alternative interpretation, the wire mesh in Adams I may not be regarded as stainless steel possessing a tensile strength of at least 200,000 psi. Adams II, however, expressly teaches that it is well known to make the coarser screens (i.e., wire mesh ranges of < 32) of stainless steel (col. 6, ln. 23-65). Further, Syte teaches that stainless steel wires with wire diameters in the 300 series, similar to those claimed, can be produced well above 200,000 psi (col. 4, ln. 64-col. 5, ln. 28; col. 9, 10 see table), thus it is implicit that 304 type stainless steel can be produced with a tensile strength at least 200,000 psi. Moreover, Syte teaches that this type of stainless steel wire possesses, in addition to enhanced tensile strength, improved torsional yields and bending limits (*Id.*). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Adams I to improve the screen's ability to withstand the vibrations and drilling fluids normally associated with shaker screens by using the stainless steel wire taught by Adams II and Syte.

### ***Response to Arguments***

Applicant's arguments that the prior art fails to teach the claimed features are unpersuasive. In particular, Applicant's argument that the prior art fails to teach the claimed type of stainless steel is unpersuasive. Here, Adams I as cited above establishes the claimed wire diameters, but is silent on the specific material used.

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Adams I, however, teaches other embodiments using stainless steel 304, thus the use of this material appears inherent. Further, Adams II clearly establishes that it is known to use stainless steel in this wire diameter range even if this material is not regarded as inherent (See also MPEP 2131.01 teaching that it would also be possible to use a secondary reference to establish inherency). Thus, any ambiguity introduced by Adams I has been eliminated by the use of the secondary Adams II reference. Further, the amended feature of sorting granular product that is "other than granular product that is food grade or corrosive to steel" is also anticipated as both Adams I and II are directed to sorting granular aggregates that are not food grade. Further, as Adams I and II already establish the use of stainless steel wire to sort granular products, there is no need to find this limitation in Syge. Syge was merely relied on to demonstrate that it is well known to make stainless steel wire with the claimed strength characteristics for commercial applications. Consequently, as a review of the prior art undermines Applicant's arguments and Applicant has failed to present sufficient evidence to the contrary, the claims stand rejected.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

"corrosive to steel" (claim 1, ln. 7-8).

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Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

<http://pair-direct.uspto.gov>

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **571-272-6584**. Further, the supervisor's contact information is Donald Walsh, 571-272-6944.

Signed by Examiner Joseph Rodriguez

jcr

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October 29, 2005

A handwritten signature in black ink, appearing to be 'JR' followed by a stylized flourish.